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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, PHILLIP H

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/714,018	Applicant(s) PIZZOLI ET AL.	
	Examiner Phillip H. Nguyen	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20031114</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the original filing of November 14, 2003. Claims 1-20 are pending and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites a system but it appears reasonable to interpret this system by one of the ordinary skill in the art as software, per se. Application's specification provides no explicitly and deliberately definition of the components ("automation script" and "script translation") that make up the system other than they could be software components, which are directed to functional descriptive material, per se, and are therefore non-statutory. Claims 2-9 are directly or indirectly depend on claim 1, and therefore, are rejected under the same reason set forth to claim 5.

Claim 19 recites a computer program, which directed to software, per se, lacking storage on a medium that enables any underlying functionality to occur, and therefore, non-statutory. Claim 20 is directly depend on claim 19, and therefore, is rejected under the same reason set forth to claim 19.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Halviatti et al (Patent Number: 5,475,843).

As per claim 1:

Halviatti discloses a system for runtime user interface automation, the system comprising:

a. automation script means for receiving an automation script for automating use of the user interface in an application ("**sends appropriate script scenes to the Script Engine**" Col 10, line 36-37; also see for example, FIG. 6, and text which further expand their features Col 21, line 35-46); and

b. script translation means for

i) intercepting a call from the automation script to a function simulating a user action on the application ("**Message Engine may trap each CreateWindow API call for determining each screen object which is about to be created**" Col 24, line 33-35),

ii) retrieving a translated text string associated with the function call ("**retrieved by a call to GetMessage(...)**" Col 7, line 55-62), and

iii) calling the function simulating the user action with the translated text string (**"class methods are provided for simulating user events. For instance, the Click(), DbClick()..."** Col 33, line 25-30; **"user interaction simulation, and Resource tracking"** Col 34, line 16; **"Each GEM can simulate any possible operation that a user would perform on any given element..."** Col 35, line 38-44).

As per claim 2:

Halviatti discloses the system as in claim 1 above; and further discloses wherein the script translating means comprises:

a. message translation means for supplying translated text for the automation script's run time execution (**"TranslateMessage()"** Col 7, line 64; **"ATUs translate low-level messages into high-level messages"** Col 22, line 39-40); and

b. selective text locator means (**"GetMessage()"** – **a message is retrieved by a call to GetMessage()"** Col 7, line 61; **retrieving a message/text is the same as locating a message/text**) coupled to the message translation means for selectively supplying appropriate text to the automation script's run time execution depending on the function call (**"the retrieved message may be translated by a call to TranslateMessage"** Col 7, line 63-64).

As per claim 3:

Halviatti discloses the system as in claim 2 above; and further discloses wherein the selective text locator means is arranged to selectively supply appropriate text to the automation script's run time execution depending on a resource ID of the function call (**"an unique id is constructed for this top level menu...the resource database is search for the record under this id...the tope level menu string from the menu handle is retrieved...a preferred name is also retrieved..."** Col 37, line 4-10).

As per claim 4:

Halviatti discloses the system as in claim 1 above; and further discloses wherein the script translation means comprises:

- a. a library (**"GEM Library" Col 31, line 21, a collection of GEMs**) including a function having the same signature as the function call and which is arranged to retrieve the translated text string before the function call (**"a GEM encapsulates the behavior of irreducible user interface elements such as push buttons, checkboxes, listboxes, menu items...when GEM is instantiated, it takes two parameters...the GEM can be instructed to run a self test method by simple comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)"** Col 31, line 60; Col 32, line 1-60); and
- b. one of:
 - i) a file (**"a GEM" Col 31, line 43**) referencing the library (**"when a GEM instantiated, it takes two parameters: a reference to its parent and..."** Col

31, line 52-44; a GEM is also considered as a file or a program, it references to its parent, a library), the automation script being arranged to reference the file and the library ("Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded..." Col 41, line 15-20; which means, when the a test script is being tested, the GEM library classes gets called), and

ii) the library including the retrieval function ("self test method is comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)" Col 31, line 51-55) and the function call ("a GEM ... a reference to its parent" Col 31, line 43-44, a call to its parent) , the library being arranged to be called by the automation script ("Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded..." Col 41, line 15-20; which means, when the a test script is being tested, the GEM library classes get called).

As per claim 5:

Halviatti discloses the system as in claim 4 above; and further discloses wherein the file referencing the library comprises an include file ("**Appendix E: Window Proxy**" Col 49).

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As per claim 6:

Halviatti discloses the system as in claim 4 above; and further discloses wherein the library including the retrieved function and the function call has the same name as a library containing the function called by the automation script ("**GEM Library**" Col 31, line 21; **GEM Library including retrieved function and function call disclosed above and is called by automation script upon invocation of a test script**).

As per claim 8:

Halviatti discloses the system as in claim 1 above; and further discloses wherein the automation script is in the English language and the application is arranged to use a non-English language ("**a lingua franca or common language for all events**" Col 9, line 20-22).

As per claim 9:

Halviatti discloses the system as in claim 1 above; and further discloses wherein the user interface comprises a graphical user interface (**FIG. 1, and text, which further expand their features, Col 5, line 51**).

As per claim 10:

Halviatti discloses a method for runtime user interface automation, the method comprising:

a. providing an automation script for automating use of the user interface in an application (**sends appropriate script scenes to the Script Engine**" Col 10, line 36-37; **also see for example, FIG. 6, and text which further expand their features Col 21, line 35-46**);

b. intercepting a call from the automation script to a function simulating a user action on the application (**"Message Engine may trap each CreateWindow API call for determining each screen object which is about to be created"** Col 24, line 33-35);

c. retrieving a translated text string associated with the function call (**"retrieved by a call to GetMessage(...)"** Col 7, line 55-62); and

d. calling the function simulating the user action with the translated text string (**"class methods are provided for simulating user events. For instance, the Click(), DbClick()..."** Col 33, line 25-30; **"user interaction simulation, and Resource tracking"** Col 34, line 16; **"Each GEM can simulate any possible operation that a user would perform on any given element..."** Col 35, line 38-44).

As per claim 11:

Halviatti discloses the method as in claim 10 above; and further discloses:

a. providing message translation means for supplying translated text for the automation script's run time execution (**"TranslateMessage()"** Col 7, line 64; **"ATUs translate low-level messages into high-level messages"** Col 22, line 39-40); and

b. providing selective text locator means means ("**GetMessage()**" – a message is retrieved by a call to **GetMessage()**" Col 7, line 61; retrieving a message/text is the same as locating a message/text) coupled to the message translation means, wherein the step of retrieving comprises selectively supplying appropriate text by the selective text locator means to the automation script's run time execution depending on the function call ("**the retrieved message may be translated by a call to TranslateMessage**" Col 7, line 63-64).

As per claim 12:

Halviatti discloses the method as in claim 11 above; and further discloses wherein the selective text locator means selectively supplies appropriate text to the automation script's run time execution depending on a resource ID of the function call ("**an unique id is constructed for this top level menu...the resource database is search for the record under this id...the tope level menu string from the menu handle is retrieved...a preferred name is also retrieved...**" Col 37, line 4-10).

As per claim 13:

Halviatti discloses the method as in claim 10 above; and further discloses wherein the script translation means comprises:

a. a library ("**GEM Library**" Col 31, line 21, a collection of GEMs) including a function having the same signature as the function call and which is called to retrieve the translated text string before the function call call ("**a GEM encapsulates the**

behavior of irreducible user interface elements such as push buttons, checkboxes, listboxes, menu items...when GEM is instantiated, it takes two parameters...the GEM can be instructed to run a self test method by simple comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)” Col 31, line 60; Col 32, line 1-60); and

b. one of:

i) a file file (“a GEM” Col 31, line 43, a GEM is consider as a file or a program, application...) referencing the library (“when a GEM instantiated, it takes two parameters: a reference to its parent and...” Col 31, line 52-44; GEM references to its parent, a library), the automation script referencing the file and the library (“Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded...” Col 41, line 15-20; which means, when the a test script is being tested, the GEM library classes gets called); and

ii) the library including the retrieved function (“self test method is comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)” Col 31, line 51-55) and the function call (“a GEM ... a reference to its parent” Col 31, line 43-44, a call to its parent, therefore, contains function call), the library being called by the automation script (“Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and

initialized the GEM library classes are loaded...” Col 41, line 15-20; which means, when the a test script is being tested, the GEM library classes get called).

As per claim 14:

Halviatti discloses the method as in claim 13 above; and further discloses wherein the file referencing the library comprises an include file (**“Appendix E: Window Proxy” Col 49**).

As per claim 15:

Halviatti discloses the method as in claim 13 above; and further discloses wherein the library including the retrieval function and the function call has the same name as a library containing the function called by the automation script (**“GEM Library” Col 31, line 21; GEM Library including retrieved function and function call disclosed above and is called by automation script upon invocation of a test script**).

As per claim 17:

Halviatti discloses the method as in claim 10 above; and further discloses wherein the automation script uses the English language and the application uses a non-English language (**“a lingua franca or common language for all events” Col 9, line 20-22**).

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As per claim 18:

Halviatti discloses the method as in claim 10 above; and further discloses wherein the user interface comprises a graphical user interface (**FIG. 1, and text, which further expand their features, Col 5, line 51**).

As per claim 19:

Halviatti discloses a computer program element comprising computer program means for:

- a. providing an automation script for automating use of the user interface in an application (**sends appropriate script scenes to the Script Engine” Col 10, line 36-37; also see for example, FIG. 6, and text which further expand their features Col 21, line 35-46**);
- b. intercepting a call from the automation script to a function simulating a user action on the application (**“Message Engine may trap each CreateWindow API call for determining each screen object which is about to be created” Col 24, line 33-35**);
- c. retrieving a translated text string associated with the function call (**“retrieved by a call to GetMessage(...)” Col 7, line 55-62**); and
- d. calling the function simulating the user action with the translated text string (**“class methods are provided for simulating user events. For instance, the Click(), DbClick()...” Col 33, line 25-30; “user interaction simulation, and Resource tracking” Col**

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34, line 16; "Each GEM can simulate any possible operation that a user would perform an any given element..." Col 35, line 38-44).

As per claim 20:

Halviatti discloses the computer program element as in claim 19 above; and further discloses

- a. providing message translation means for supplying translated text for the automation script's run time execution ("**TranslateMessage()**" Col 7, line 64; "**ATUs translate low-level messages into high-level messages**" Col 22, line 39-40); and
- b. providing selective text locator means means ("**GetMessage()**" – **a message is retrieved by a call to GetMessage()**" Col 7, line 61; **retrieving a message/text is the same as locating a message/text**) coupled to the message translation means, wherein the step of retrieving comprises selectively supplying appropriate text by the selective text locator means to the automation script's run time execution depending on the function call ("**the retrieved message may be translated by a call to TranslateMessage**" Col 7, line 63-64).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halviatti et al. (Patent Number: 5,475,843), in view of Laane (Patent No.: US 6,978,445 B2).

As per claim 7:

Halviatti discloses the system as in claim 1 above, but does not explicitly disclose wherein the automation script comprises a Java™ script.

However Laane discloses an analogous system including Java™ script (**"Javascript" Col 5, line 47**).

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Halviatti's system to include Java™ script. One of the skilled in the art would have been motivated to modify Halviatti's system because the user select the value from the dropdown, hits Go, and the choice is made. By using Java™ script, a programmer can have the list notify him/her when a change is made, and a programmer can essentially hit that Go button for the user. This saves the use all the hassle of clicking on a button.

As per claim 16:

This is a method claim reciting the limitation as recited in claim 7 above, and therefore, has been addressed in connection with the rejection of claim 7.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Friday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN
11/27/06

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11-27-2006